

Appl. No. 09/922,813
Amdt. dated January 24, 2005
Reply to Office Action of August 25, 2004

REMARKS/ARGUMENTS

Claims 1-69 are pending in the present application. In the Office Action mailed August 25, 2004, the Examiner rejected claims 1-69 under 35 U.S.C. § 103(a). Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

A. Rejection of Claims 1-15, 24-31 and 42-49 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-15, 24-31 and 42-49 under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,160,477 to Sandelman et al. (hereinafter, "Sandelman") in view of U.S. Publication No. 2002/0019712 to Petite et al. (hereinafter, "Petite") and in further view of U.S. Publication No. 2002/0198978 to Watkins (hereinafter, "Watkins"). This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

The claims at issue relate to a communications module for facilitating electronic communications with an electronic device. Claim 1 recites that the communications module

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comprises both “a paging module … for communicating with a computer through a paging network” and “a modem … for communicating with the computer through a communications network.” The other claims at issue include identical or similar limitations.

Sandelman discloses a system and method for monitoring remote equipment such as HVAC equipment. A piece of equipment to be monitored is fitted with an interface unit 10. When a predetermined exception condition occurs in the piece of equipment being monitored, the interface unit 10 sends an exception message to a message delivery server 1. The message delivery server 1 then routes the message to an appropriate end device.

Petite discloses a system for providing remote monitoring of electricity consumption. The system includes an applications server 110, one or more site controllers 150, and a series of remote devices, such as sensors 140 and sensors/actuators 130. The site controllers 150 communicate with the applications server 110 via a wide area network 120.

Neither Sandelman nor Petite, alone or in combination, teach or suggest a communication module that has both a paging module and a modem, as recited in the claims at issue. The Examiner acknowledges this in the Office Action. See Office Action, page 3 (“Sandelman in view of Petite does not specifically teach a paging module for communicating with a computer through a paging network.”).

Watkins discloses a system to remotely control and monitor devices and data. The system includes a remote control unit 10 which has one or more communication modules 22. “The communication module(s) 22 provides the remote sending and/or receiving of data (and remote control and monitoring) capability for the RCU.” Watkins, par. 35. Watkins states that “[e]xamples of communication modules 22 are 1way paging data receivers, 2-way paging data receivers/transmitters” Id.

In the Office Action, the Examiner asserts that it would have been obvious to use the paging data receivers/transmitters taught in Watkins in the electronic message delivery server of Sandelman in order to “provid[e] an alternative wireless means for remotely controlling and monitoring said HVAC system.” Office Action, page 4. Applicants respectfully disagree. Applicants cannot find –

and the Examiner did not point out – anything in the cited references which teaches or suggests the desirability of having such an “alternative wireless means” for remote control in the electronic message delivery server 1 of Sandelman.

Sandelman itself says nothing about the desirability of having two alternative means of communication in the electronic message delivery server 1. Sandelman indicates that “[t]he message delivery server 1 ... routes the message as an outgoing exception message to the appropriate user interface; email 6, fax 7, pager 8, voice 9, etc., according to the message profile as configured by the user of the system 21 via the Internet 122.” Sandelman, col. 6, lines 42-46. Thus, Sandelman teaches that the exception message may be sent to an end device by email, fax, pager, voice, etc. However, the message delivery server 1 itself only includes a single means of communication. This can be seen in the following passage from Sandelman, which explains how an outgoing exception message is routed to an end device:

FIGS. 3a-d show a more detailed view of the various outbound links 12a-d that connect the server 1 to the various electronic media. In FIG. 3a, server 1 sends the message over a telephone line 18a to the Internet 122 and deposits the message in the user's e-mail box 6. In FIG. 3b, server 1 sends the message over a telephone line 18b through the public telephone switched network (PTSN) 19 to the user's fax machine 7. In FIG. 3c, server 1 sends the message over a telephone line 18c to the user's pager service 53 and thence to the user's pager or PCS 8. In FIG. 3d, server 1 sends the message over a telephone line 18d through the PTSN 19 to the user's voice mail box 9.

Sandelman, col. 7, lines 9-23 (emphasis added). As can be seen from the foregoing, the message delivery server 1 is clearly only equipped to send messages “over a telephone line.” Therefore, the message delivery server 1 only includes a single means of communication, presumably a telephone modem. Nowhere in Sandelman is there any teaching or suggestion that it would be desirable to include an alternative means of communication in the message delivery server 1, as the Examiner proposes.

Watkins also does not include any teaching or suggestion about the desirability of having two alternative means of communication in a communications module. As indicated above, Watkins merely states that “[e]xamples of communication modules 22 are 1way paging data receivers, 2-way

paging data receivers/transmitters,” Watkins, par. 35. Thus, at the very most Watkins teaches that a communications module 22 may be embodied as a 1-way or 2-way pager. However, there is no teaching or suggestion in Watkins that two different types of communication modules 22 may be used with one another, and certainly not that a pager may be used together with a modem.

Petite is similarly silent about the desirability of having two alternative means of communication in a communications module. As indicated above, Petite teaches that “one or more site controllers 150 and the applications server 110 may communicate via one or more communication networks, such as a wide area network (WAN) 120 or other suitable communication network.” Petite, par. 23. However, there is no teaching or suggestion that the site controllers 150 are configured to communicate with the applications server 110 via two different types of communication networks. The vague reference to “one or more communication networks” certainly cannot be construed as such a teaching or suggestion. Petite specifically mentions only one type of communication network, namely a WAN 120.

The Examiner refers to the combination of a paging module and a modem as “a design preference.” Office Action, page 4. Applicants respectfully disagree. A communication module that includes both a paging module and a modem for communicating with a computer has a number of advantages over systems with just one means of communication. However, these advantages are not contemplated in the cited references.

The claimed communications module, which includes both a modem and a paging module, possesses several advantages compared to a device that only includes paging capability. For example, the cost of sending data via a modem is typically lower than the cost of sending data via a paging network. In addition, power may be scavenged from the modem link to power the communications module.

The claimed communications module also possesses several advantages compared to a device that only includes a modem. For example, the claimed paging module may be used to implement multicast communications with several communications modules. Furthermore, the paging module

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may be used to trigger a dial-out from the communications module to the computer when the computer needs to send messages to the communications module.

The cited references do not contemplate any of these advantages associated with having both a paging module and a modem in a communications module. In fact, the cited references do not even contemplate any disadvantages associated with having only a single means of communication in the disclosed devices. Sandelman does not discuss any disadvantages associated with only having a modem in the disclosed message delivery server 1. Watkins does not discuss any disadvantages associated with only using a pager in the disclosed communications modules 22. Petite does not discuss any disadvantages associated with only communicating via a WAN 120.

The Examiner has not pointed to any part of the cited references as suggesting the desirability of having both a paging module and a modem together in a single communications module. The only place where Applicants have found any teaching regarding the desirability of this combination is in Applicants' own disclosure. Accordingly, it appears that the Examiner has simply "take[n] the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." In re Dembicza, 175 F.3d 994, 999 (Fed. Cir. 1999)). The MPEP warns against this kind of improper hindsight reasoning:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. ... The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP § 2142 (emphasis added).

In view of the foregoing, Applicants respectfully submit that claims 1-15, 24-31 and 42-49 are patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

B. Rejection of Claims 16-23, 32-41 and 50-69 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 16-23, 32-41 and 50-69 under 35 U.S.C. § 103(a) based on Sandelman in view of Petite and Watkins, and in further view of U.S. Publication No. 2002/0016639 to Smith et al. (hereinafter, “Smith”). This rejection is respectfully traversed.

The standard for establishing a rejection under 35 U.S.C. § 103(a) is provided above. Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

The claims at issue relate to a communications module for facilitating electronic communications with an electronic device. Some of the claims at issue depend from claim 1, which recites that the communications module comprises both “a paging module … for communicating with a computer through a paging network” and “a modem … for communicating with the computer through a communications network.” The other claims at issue include identical or similar limitations.

As discussed above, Sandelman, Petite and Watkins do not teach or suggest a communications module that includes both a paging module and a modem. Smith discloses “a software system that allows for control of, and/or communication with, end devices and communication systems that utilize different command and communications protocols and languages.” Smith, par. 2. The system includes “software modules which are adapted to directly control different types of building systems.” Id., par. 90.

In the Office Action, the Examiner asserts that “messages to be sent to the various subsystems can be stored in a message queue” and “it would have been obvious … to use the inbound message queue taught in Smith in the remote system of Sandelman.” Office Action, page 17. Even if the Examiner’s assertions were correct, this would not overcome the shortcomings of Sandelman, Petite and Watkins discussed above. Smith does not include any teaching or suggestion about the desirability of having two alternative means of communication in a communications module. Accordingly, the combined teachings of Sandelman, Petite, Watkins and Smith do not teach or suggest all of the limitations in the claims at issue.

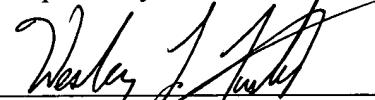
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In view of the foregoing, Applicants respectfully submit that claims 16-23, 32-41 and 50-69 are patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

C. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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